

**REMARKS**

Double Patenting Rejection:

Applicants are filing a terminal disclaimer herein to overcome the non-statutory obviousness-type double patenting rejection as being unpatentable over claims 1-8 of commonly owned co-pending U.S. Pat. Appl'n. No. 10/568,110 in view of Kawachi (U.S. 2003/048961. Accordingly, Applicants respectfully request this rejection be withdrawn.

Claim Rejections Under 35 U.S.C. §112:

Claim 12 has been amended to overcome the rejection of claims 12-14 as not complying with the enablement requirement as well as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention. The reference to "subdividing" and "shaping" in claim 12 has been removed. Accordingly, Applicants respectfully request this rejection be withdrawn.

Claim 9 has been amended to overcome the rejection of claims 9-11 as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention. Per the Examiner's request, the "and/or" language has been removed. Accordingly, Applicants respectfully request this rejection be withdrawn.

Given no other rejection for claims 9-14 was presented by the Examiner. Regardless, claim 12 has been amended to further recite patentable subject matter over all the references cited. As amended, claim 12 further recites applying a nickel intermediate layer having a thickness greater than 4  $\mu\text{m}$  onto the bearing metal layer and electrodepositing an overlay consisting of about 0 - 20 wt.% copper and silver, the rest being bismuth, onto the nickel intermediate layer. Accordingly, these claims are now believed to be in condition for allowance. Such action is respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a):

Applicants respectfully traverse the rejection of claims 1-7 as being unpatentable over Kawachi (U.S. 2003/0048961, referred to hereafter as the '961 reference'). Applicants have amended claim 1 to more clearly recite patentable subject matter over the '961 reference, and thus, request the rejection be withdrawn.

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As amended, claim 1 recites a composite multilayer material having a backing layer, a bearing metal layer of a copper alloy or an aluminum alloy, a nickel intermediate layer and an overlay. The overlay consists of about 0 - 20 wt.% copper and silver, the rest being bismuth, and the layer thickness of the nickel layer amounts to more than 4  $\mu\text{m}$ .

In contrast, the '961 reference discloses an overlay of consisting of either bismuth and copper, or bismuth and silver (paragraphs [0011-0016], [0025], [0036-0037], and illustrated in Table 1). There is no disclosure in the '961 reference, let alone a suggestion form an overlayer using copper and silver of about 0 - 20 wt.%, with the rest being bismuth. One having ordinary skill in the art would be inclined to use one or the other of copper or silver with bismuth based on the teaching of the '961 reference. To arrive at any other conclusion requires use of improper hindsight in view of Applicants invention.

Accordingly, amended claim 1 is believed to define patentable subject matter and to be in proper form for allowance. Such action is respectfully requested.

Claims 2-7 are ultimately dependant upon amended claim 1, and thus, are believed to define patentable subject matter for at least the same reasons and to be in proper form for allowance. Such action is respectfully requested.

Applicants respectfully traverse the rejection of claims 1-8 as being unpatentable over Kawachi (U.S. 2004/0241489, referred to hereafter as the '489 reference') in view of the '961 reference.

As discussed above, Applicants have amended claim 1 to more clearly recite patentable subject matter wherein the recited overlay consists of about 0 - 20 wt.% copper and silver, the rest being bismuth, and the layer thickness of the nickel layer amounts to more than 4  $\mu\text{m}$ .

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As acknowledged by the Examiner, the '498 reference discloses use of an overlay of bismuth alloy containing 0.1-10 wt.% copper and 0.5-10 wt.% tin (paragraph [0008]). Further, Table 1 shows various specimen with overlays of Bi, Cu, Sn, In and Sb. However, this is not what is being claimed by Applicants. As amended, Applicants are claiming an overlay consisting of about 0 - 20 wt.% copper and silver, the rest being bismuth. Neither the '489 reference or the '961 reference, either individually or in combination, disclose or suggest such an overlay.

Accordingly, amended claim 1 is believed to define patentable subject matter and to be in proper form for allowance. Such action is respectfully requested.

Claims 2-8 are ultimately dependant upon amended claim 1, and thus, are believed to define patentable subject matter for at least the same reasons and to be in proper form for allowance. Such action is respectfully requested.

**New Claims**

Claims 17 and 18 have been added. The claims recite a crankshaft main bearing and a connecting rod bearing, respectively, consisting of a composite multilayer material having a backing layer, a bearing metal layer of a copper alloy or an aluminum alloy, a nickel intermediate layer and an overlay, wherein the overlay comprises about 0 - 20 wt.% copper and/or silver, the rest being bismuth, and the layer thickness of the nickel layer amounts to more than 4  $\mu\text{m}$ .

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It is believed that this application now is in condition for allowance. Further and favorable action is requested.

Payment of the 2 month extension of time fee in the amount of \$450 is being paid through electronic filing.

The Patent Office is authorized to charge or refund any fee deficiency or excess to Deposit Account No. 04-1061.

Respectfully submitted,

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**June 5, 2007**

Date

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